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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,463	10/15/2001	William C. Johnson JR.	GEO-55	3692

7590

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EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,463

Applicant(s)

JOHNSON JR.

Examiner

Anthony D Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3728

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the international reference to Techboot WO 92/14372 (WO '372). WO '372 discloses all the limitations of the claim including the following: a boot (see Figure 2) having an outer layer 35 of leather stretched over an oversized toe box 27 located beneath the outer layer; a layer of compressible cold insulating material 43 secured to the inside of the toe box in an uncompressed state; a lining 34 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 10.

Claim Rejections - 35 USC § 103

Art Unit: 3728

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 in view of Official Notice. WO '372 discloses all the limitations substantially as claimed except for the thickness of the insulating material. Official Notice is taken that it would be obvious to one of ordinary skill in the art, at the time the invention was made, to make the insulating material any thickness to insulate the boot to the hold the desired temperature. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the insulation layer of WO '372 the desired thickness to insulate the boot to the desired temperature to keep the user's feet warm in cold temperatures.

5. Claims 1, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over White 3,805,419 or Adams 4,102,062 in view of WO 92/14372.

Art Unit: 3728

White '419 disclose all the limitations substantially as claimed including the following: a boot (see Figure 1) having an outer layer 8 stretched over an oversized toe box 1 located beneath the outer layer; a layer of compressible cold insulating material 5 secured to the inside of the toe box in an uncompressed state (fastened to sole therefore not compressing uncompressed layer 5 to toe cap); a lining 6 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 9.

Adams '062 discloses all the limitations substantially as claimed including the following: a boot (see Figure 1) having an outer layer 11 stretched over an oversized toe box 13 located beneath the outer layer; a layer of compressible cold insulating material 25 secured to the inside of the toe box in an uncompressed state (fastened to sole and not shown compressed between liner and toe box); a lining 24 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 14.

Art Unit: 3728

Neither White '419 nor Adams '062 discloses the outer layer being leather or the thickness of the insulating layer. WO '372 teaches that a leather exterior boot can have a toe box, insulating layer and lining located beneath the outer leather layer of a work boot to aid in insulating the user's foot from cold weather. Therefore, it would have been obvious, in view of WO '372, to make the boot used in each of White '419 or Adams '062 out of leather, as taught by WO '372, to aid in protecting the user's foot from impacts. With respect to the limitations of the thickness of the insulating layer, Official Notice is taken that it would be obvious to one of ordinary skill in the art, at the time the invention was made, to make the insulating material any thickness necessary to insulate the boot to hold the desired temperature. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the insulation layer of the reference noted above the desired thickness to insulate the boot to the desired temperature to keep the user's feet warm in cold temperatures.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being obvious over any of the references applied to claim 1 above. The references as applied to claim 1 above disclose all the limitations of the claim including a layer of insulating material located under the toe box. In all of the references,

there is an insole located under the toe box, which meets the limitation of the claim since the insole can act as an insulating material and is located under the toe box.

Response to Arguments

7. Applicant's arguments filed August 25, 2003 have been fully considered but they are not persuasive. Applicant argues that the non-flammable foam layer of WO '372 is secured inside the toe box in its compressed state, as seen in Figures 2 and 4. This argument is not clearly understood. The foam layer 43 of WO '372 is clearly shown in an uncompressed state. As the boot is placed upon the foot, the elastic band 26 would pull the upper portion over the instep of the foot closer towards the foot and thereby compress the foam layer against the foot to firmly hold the boot on the user's foot. Also, ester foam is known as an open-celled foam which is typically used in an uncompressed state. Applicant further argues that there is no reason to believe that the toe box is "oversized". This argument is not clearly understood. The toe box 1 of White is sized to comfortably fit over top of the user's foot as the user places his foot within the toe, with a layer of compressible cushioning material 5 located between the toe box and the user's foot, thereby making the toe box "oversized". With respect to

Art Unit: 3728

the applicant's argument that the outer layer is not stretched over the toe box, and the recitation of col. 5, lines 13-17, while the toe box of White is placed within the shoe, it would stretch the upper over the toe cap, i.e. press against the upper layer, during insertion to provide the proper pressure to adhere the toe cap to the outer layer. Applicant further argues that the toe box of Adams is not "oversized". The same argument for White and the term "oversized" applies here.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125

Application/Control Number: 09/977,463

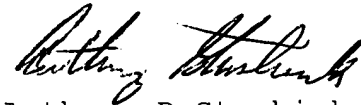
Page 9

Art Unit: 3728

Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/



Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS

December 1, 2003